

## REMARKS

### INTRODUCTION:

As set forth in the preceding section, no claims have been added, amended or cancelled herein.

Claims 1-6 and 8 are pending in the present application. Claims 1, 3, 5, 6 and 8 are independent claims. Reconsideration of the claims in view of the following remarks is respectfully requested.

### REJECTIONS UNDER 35 USC § 103:

Claims 1-6 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Publication No. 2004/0001704 by Chan et al. ("Chan") in view of U.S. Patent No. 5,915,038 to Abdel-Mottaleb et al. ("Abdel-Mottaleb") and further in view of U.S. Patent No. 5,832,170 to Keery et al. ("Keery"). Claim 8 stands rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,833,848 to Wolff et al. ("Wolff") in view of Abdel-Mottaleb and further in view of Keery. All of the rejections are respectfully traversed.

Independent claim 8 recites at least the following:

inputting index information of a still picture other than one currently being played;

Wolff, Chan, Abdel-Mottaleb, and Keery, alone or in combination, fail to suggest or disclose all of the above-recited features of independent claim 8.

The Office Action concludes at page 8, that Wolff describes all of the above-recited features at column 5, lines 52-67. Applicant respectfully disagrees with the Office Action conclusion for at least the following reasons.

Wolff is directed to a system that combines capabilities for storing, authoring, and viewing various forms of digital media wherein a display means displays imported objects in a first track, authored stories in a second track and authored stories that are part of a story under creation in a third track. The portion of Wolff cited in the Office Action describes that a user may select a thumbnail and view an image from one story, while adding it to the current story.

Applicant asserts, however, that selecting a thumbnail of an image is not the same as "inputting index information of a still picture," as claimed. Moreover, the cited portion of Wolff

fails to describe "inputting index information of a still picture other than one currently being played," because the cited portion of Wolff describes the user selecting a thumbnail image that is being currently displayed.

The cited portion of Wolff, therefore, fails to describe all of the above-recited features.

Chan is directed to a slide show providing device having a single playback mode including various user-selected combinations of still images and music files, chosen from images and music files stored in memory. The Office Action separately concludes with respect to claim 5, at page 6, that Chan illustrates and describes all of the above-recited features at FIGS. 4 and 6 and pars. [0032], [0036] and [0037]. Applicant respectfully disagrees with the Office Action conclusion for at least the following reasons.

FIG. 4 of Chan merely illustrates a remote control device having left and right and up and down buttons and therefore, absent some other suggestion, FIG. 4 fails to describe all of the above-recited features.

FIG. 6 of Chan merely illustrates an information screen displaying a listing of video files 6-1 - 6-3 located on an optical disc, audio files 7-1 - 7-3 located on the optical disc, and video files 6-4 and 6-5 on some other inserted media (Aux. Reader Information) (see Chan, par. [0036]). Accordingly, absent some other suggestion, FIG. 6 fails to describe all of the above-recited features.

In addition, Chan describes a number of different playback modes that may be selected by a user allowing playback of still video images with music files. The play back modes are accomplished using a processor chip 100, which "may create in real time an association between still images and audio tracks. The playback modes include: **1)** a first mode, which may present the contents of video files 6 - 1 to 6 -N one by one (and each for a predetermined period of time, e.g., 30 seconds) in order beginning with the first or a selected video file 6, and during this time, each audio file 7 - 1 to 7 -N may be played one by one in order beginning with the first or a selected audio file 7; **2)** a second mode, in which a user 1 may select one and only one audio file 7 to be played while the video files 6 - 1 to 6 -N are presented in order starting from the first or a selected video file 6 - 1; **3)** a third mode, in which a user 1 may select a playlist of audio files 7 - 1 to 7 -N to be played while the video files 6 - 1 to 6 -N are presented in order starting from the first or a selected video file 6 - 1; **4)** a fourth mode, which may present a playlist of video files 6 - 1 to 6 -N in order while a playlist of audio files 7 - 1 to 7 -N are played in order; **5)** a fifth mode, which may present all the video files in a random order starting from a randomly selected file or a file selected by the user 1 , while the processor chip 100 may automatically

select one or more audio files 7 for playback; and 6) a sixth mode, in which a user 1 may specify a one-to-one correspondence between video and audio files using a simple menu interface (e.g., a keypad 410 of a remote control device 15 ) (see Chan, par. [0037]).

However, none of the modes above from Chan describe inputting index information of a still picture other than a still picture currently being played as recited in claim 8. In fact, Chan would have no reason to describe such a feature because each of the modes of Chan is directed to a single playback mode including various user-selected combinations of images and music files, chosen from images and music files stored in memory.

The cited portions of Chan, therefore, fail to describe all of the above-recited features.

Further, the Office Action fails to establish that Abdel-Mottaleb, and Keery, alone or in combination, compensate for the asserted deficiencies of Wolff and Chan.

Independent claim 8 further recites at least the following:

reproducing the still picture and the corresponding audio stream in  
place of the one currently being played

Chan, Wolff, Abdel-Mottaleb, and Keery, alone or in combination, fail to suggest or disclose all of the above-recited features of independent claim 8.

The Office Action concludes at page 8, that Wolff illustrates and describes all of the above-recited features at FIG. 2 and column 7, lines 34-63. Applicant respectfully disagrees with the Office Action conclusion for at least the following reasons.

The portion of Wolff cited in the Office Action, states in part:

If the user navigates to a new thumbnail image while the system is playing, for example scrolling left or right, changing to a different track, playback of the currently playing audio clip is stopped. If the user takes no further action for a brief length of time (e.g., one second); the system plays the audio clip associated with the newly selected thumbnail image and continues with that story from that point on.

Thus, the above-cited text describes "play[ing] the audio clip associated with the newly selected thumbnail image" in place of a "currently playing audio clip [that] is stopped," but the text is silent with regard to *stopping the display of a thumbnail image* associated with the stopped audio clip. The cited portion of Wolff, therefore, fails to describe all of the above-recited features.

With respect to Chan, none of the modes set forth in par. [0037] of Chan describe that

"while playing a slide show a user may choose to play a different still image file and corresponding audio stream." In fact, and as set forth in more detail directly above, Chan would have no reason to describe such a feature because each of the modes of Chan is directed to a single playback mode including various user-selected combinations of images and music files stored in memory. Consequently, Chan also fails to describe all of the above-recited features.

Further, the Office Action fails to establish that Abdel-Mottaleb, and Keery, alone or in combination, compensate for the asserted deficiencies of Wolff and Chan.

Accordingly, Applicant respectfully submits that claim 8 patentably distinguishes over Wolff, Chan, Abdel-Mottaleb, and Keery, and should be allowable for at least the above-mentioned reasons. Since similar features recited by independent claim 5, with potentially differing scope and breadth, are not suggested or disclosed by Wolff, Chan, Abdel-Mottaleb, and Keery, the rejection should be withdrawn and claim 5 also allowed.

Further, Applicant respectfully submits that claims 2 and 4, which variously depend from independent claims 1 and 3, should be allowable for at least the same reasons as claims 1 and 3, as well as for the additional features recited therein.

Independent claim 1 recites at least the following:

a controller outputting the target still picture stored in the second storage when index information of the target still picture is received from a user...

Chan, Wolff, Abdel-Mottaleb, and Keery, alone or in combination, fail to suggest or disclose all of the above-recited features of independent claim 8.

The Office Action concludes at page 2, that Chan describes all of the above-recited features at paragraph [0037] which describes playback and presentation modes 6-1 to 6-N or 7-1 to 7-N. Applicant respectfully disagrees with the Office Action conclusion for at least the following reasons.

The cited portion of Chan describes a number of different playback modes that may be selected by a user allowing playback of still video images with music files. The play back modes are accomplished using a processor chip 100, which "may create in real time an association between still images and audio tracks. The playback modes include: 1) a first mode, which may present the contents of video files 6 - 1 to 6 -N one by one (and each for a predetermined period of time, e.g., 30 seconds) in order beginning with the first or a selected video file 6, and during this time, each audio file 7 - 1 to 7 -N may be played one by one in order beginning with the first

or a selected audio file 7; **2)** a second mode, in which a user 1 may select one and only one audio file 7 to be played while the video files 6 - 1 to 6 -N are presented in order starting from the first or a selected video file 6 – 1; **3)** a third mode, in which a user 1 may select a playlist of audio files 7 - 1 to 7 -N to be played while the video files 6 - 1 to 6 -N are presented in order starting from the first or a selected video file 6 – 1; **4)** a fourth mode, which may present a playlist of video files 6 - 1 to 6 -N in order while a playlist of audio files 7 - 1 to 7 -N are played in order; **5)** a fifth mode, which may present all the video files in a random order starting from a randomly selected file or a file selected by the user 1 , while the processor chip 100 may automatically select one or more audio files 7 for playback; and **6)** a sixth mode, in which a user 1 may specify a one-to-one correspondence between video and audio files using a simple menu interface (e.g., a keypad 410 of a remote control device 15 ) (see Chan, par. [0037]).

Although the cited portion of Chan describes modes allowing a user to select various combinations of audio and video files, none of the modes describe “outputting the target still picture stored in the second storage *when index information* of the target still picture is received from a user” as recited in claim 1. In fact, the cited portion of Chan is completely silent with regard to index information.

Accordingly, the Office Action fails to specifically set forth if and where the above-claimed features are disclosed in Chan. If the rejection is to be maintained, Applicant respectfully requests the Office support the rejection with a specific paragraph number and figure reference, or specifically indicate if an assertion of inherency is being relied upon. If an assertion of inherency is being relied upon, Applicant requests the next Office Action provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art” as required by MPEP 2112 IV. Further, the Office Action should be made non-final to give Applicant an opportunity to review the Office’s position as to these arguments and to clarify the record for appeal.

Wolff describes that a user may select a thumbnail and view an image from one story, while adding it to the current story. Applicant asserts, however, that selecting a thumbnail of an image is not the same as receiving “index information of the target still picture” from a user, as claimed.

The cited portion of Wolff, therefore, fails to describe all of the above-recited features.

Further, the Office Action fails to establish that Abdel-Mottaleb, and Keery, alone or in combination, compensate for the asserted deficiencies of Wolff and Chan.

Independent claim 1 further recites at least the following:

a controller outputting the target still picture stored in the second storage when index information of the target still picture is received from a user, by comparing the received index information with a maximum number of indexes included in a predetermined track of the optical disk currently being played

Chan, Wolff, Abdel-Mottaleb, and Keery, alone or in combination, fail to suggest or disclose all of the above-recited features of independent claim 8.

The Office Action notes at page 2, that Chan "does not expressly disclose comparing the received index information with a maximum number of indexes included in a predetermined track of the optical disk currently being played." However, the Office Action proposes to modify Chan with Abdel-Mottaleb and asserts that Abdel-Mottaleb illustrates and describes "comparing the received index information with a maximum number of indexes included in a predetermined track of the optical disk" at (FIG. 2, column 1, lines 24-32, column 5, lines 47-67, column 6 lines 1-23, column 7, lines 51-67 and column 13, lines 29-45). Applicant respectfully disagrees with the Office Action assertion for at least the following reasons.

Abdel-Mottaleb is directed to an image information retrieval system extracting index keys from still images and comparing an index key extracted from a query image to the extracted index keys (column 14, lines 35-65). The cited portions of Abdel-Mottaleb describe the retrieval of images similar to the query image, as illustrated in FIG. 2. However, none of the cited portions of Abdel-Mottaleb describe "comparing the received index information with a maximum number of indexes included in a predetermined track of the optical disk currently being played." For example, in describing step 206 of FIG. 2, Abdel-Mottaleb states, in part:

In step 206, an index key corresponding to each image being searched is extracted. If 100 images are to be searched, 100 total index keys are extracted, with one index key corresponding to each image. As explained above, the index keys could have been previously extracted and stored in a database, in which case the database is searched for similarity to the index key extracted from the query image. Also as explained above, each image may have multiple index keys based upon different components, or different combinations of components, of the DCT coefficients for that image.

It can thus be seen from the above-cited text that Abdel-Mottaleb fails to describe the index keys as being limited to "a predetermined track of the optical disk currently being played," as recited in claim 1. In fact, a word search of Abdel-Mottaleb reveals that Abdel-Mottaleb fails to even mention either the term track or the term maximum, as recited in claim 1.

In addition, the Office Action fails to establish that Wolff and Keery, alone or in combination, compensate for the asserted deficiencies of Abdel-Mottaleb and Chan.

Accordingly, Applicant respectfully submits that claim 1 patentably distinguishes over Wolff, Chan, Abdel-Mottaleb, and Keery, and should be allowable for at least the above-mentioned reasons. Since similar features recited by independent claims 3, 5, 6, and 8, with potentially differing scope and breadth, are not suggested or disclosed by Wolff, Chan, Abdel-Mottaleb, and Keery, the rejection should be withdrawn and claims 3, 5, 6, and 8 also allowed.

Further, Applicant respectfully submits that claims 2 and 4, which variously depend from independent claims 1 and 3, should be allowable for at least the same reasons as claims 1 and 3, as well as for the additional features recited therein.

#### Insufficient Reason to Combine Articulated

Applicant respectfully submits that the rejection fails to establish a prima facie case of obviousness. To establish a prima facie case of obviousness: 1) there must be some suggestion or reason to combine the references, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art; 2) there must be a reasonable expectation of success; and 3) the references must either teach or suggest all the claim limitations or the Office must provide a rationale as to why the differences between the claimed invention and the prior art are obvious. MPEP 2141.

Here, no citation to the prior art has been offered as providing a suggestion or reason to modify and combine Chan, Abdel-Mottaleb and Keery, nor does the Office Action provide evidence demonstrating an implicit reason to modify and combine the documents. In *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 127 SCt 1727, 167 LEd2d 705 (U.S. 2007), the U.S. Supreme Court held that in determining obviousness, it is necessary “to determine whether there was an apparent reason to combine the known elements in the fashion claimed” *KSR*, slip op. 14, 82 USPQ2d at 1396. Further, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR* at 1396, quoting *In re Kahn*. With respect to the rejection of claim 1, the reasoning provided, at page 3 of the Office Action, for combining Chan, Abdel-Mottaleb and Keery states:

“At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Chan as modified with the teachings of Keery. Rationale to combine would have been that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and

combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.”

Applicant asserts that the Office Action fails to provide any rationale whatsoever for combining Chan, Abdel-Mottaleb and Keery, as evidenced by the above-cited Office Action text, which essentially states that one skilled in the art at the time of the invention would have been motivated to combine Chan and Keery because one skilled in the art “could have combined the elements.” In rebuttal, Applicant asserts that simply being able to combine elements does not provide a reason for doing so.

At best, the cited rationale for combining Chan and Keery is merely a conclusion and therefore fails to meet the standard articulated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* The rejection is based on the Office’s conclusion that it would have been obvious to use the storing of image data on the three tracks of a laser disk from Keery in the method of processing a still image slide show from a DVD as described in Chan, since the combination “would have yielded predictable results.”

However, other than the Office’s conclusion of such “predictable” results, there is no evidence in the record as to why one skilled in the art would have found the combination of Chan and Keery’s storing of image data on three tracks of a laser disk as obvious. It is further submitted that the reliance on Keery, which discusses many techniques without any particular relevance to the method of Chan, is unreasonable.

Although Applicant believes the rejection is based upon impermissible hindsight, Applicant has more particularly articulated that the Office has based the rejections upon an incorrect interpretation of *KSR* and the discussed permissible “predictable results” analysis presented therein.

The mere fact that a reference may be modified in the manner suggested in the Office Action does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 972 F. 2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). There must be a reason for such a modification of Chan, other than merely the storing of image data of Keery being possible.

For example, there may be many different techniques for storing image data that are different from both Chan and Keery that may also have been used by one skilled in the art at the time of the invention.

Here, again, it would appear that the Office has merely performed a brief word search for the storing described in the detailed description of the present application, found Keery, and then



concluded that it would have been obvious to use the storing method of Keery in Chan.

To support the Examiner's conclusion, the Examiner has merely relied upon the discussion within KSR of predictable results, i.e., concluding that the use of the the storing method of Keery would have presented predictable results.

This is an incorrect application of the "predictable results" reason for obviousness. Further, the conclusory statement regarding the storing method of Keery is not "evidence" of either the reason for the modification or of the predictable results of the use of such a storing method.

As more clearly explained in the recent Federal Circuit decision *Eisai v. Dr. Reddy's and Teva* (07-1397/98):

In KSR, the Supreme Court noted that an invention may have been obvious "[w]hen there [was] . . . a design need or market pressure to solve a problem and there [were] . . . **a finite number of identified, predictable solutions.**" 127 S. Ct. at 1742 (tense changes supplied to clarify, as the Court stated and as per 35 U.S.C. § 103, that the obviousness inquiry must rely on evidence available "at the time" of the invention, see *Takeda*, 492 F.3d at 1356 n.2). The Supreme Court's analysis in KSR thus relies on several assumptions about the prior art landscape. First, KSR assumes a starting reference point or points in the art, prior to the time of invention, from which a skilled artisan might identify a problem and pursue potential solutions. Second, KSR presupposes that the record up to the time of invention would give some reasons, available within the knowledge of one of skill in the art, to make particular modifications to achieve the claimed compound. See Takeda, 492 F.3d at 1357 ("Thus, in cases involving new chemical compounds, it remains necessary to identify some reason that would have led a chemist to modify a known compound in a particular manner to establish prima facie obviousness of a new claimed compound."). Third, the Supreme Court's analysis in KSR presumes that the record before the time of invention would supply some reasons for narrowing the prior art universe to a "finite number of identified, predictable solutions." 127 S. Ct. at 1742. In *Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc.*, 520 F.3d 1358, 1364 (Fed. Cir. 2008), this court further explained that this "easily traversed, small and finite number of alternatives . . . might support an inference of obviousness." To the extent an art is unpredictable, as the chemical arts often are, KSR's focus on these "identified, predictable solutions" may present a difficult hurdle because potential solutions are less likely to be genuinely predictable. (Emphasis added).

Thus, with the storing method of Keery not being within such a small and finite number of alternatives, and with the only evidence in the record identifying the starting point of one skilled in the art being the Office Action conclusion that such a combination would have been possible, it would not have been obvious to now selectively choose the storing method of Keery and substitute the same into the system of Chan.

In addition, similar to the above notation from KSR, it is again noted that "the Board [and Examiner] cannot simply reach conclusions based on [their] own understanding or experience - or on [their] assessment of what would be basic knowledge or common sense. Rather the Board [and Examiner] must point to some **concrete evidence in the record in support of these findings**." In re Zurko, 258 F. 3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). See also In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).

Likewise, see In re Lee, 277 F. 3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), in which the court **required** evidence for the determination of unpatentability by clarifying that the principles of "***common knowledge***" and "***common sense***" may only be applied to the analysis of evidence, rather than be a substitute for evidence.

Lastly, see W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) ("To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.")

Thus, the fact that a the storing method may be discussed in Keery without any particular relationship to the slide show with audio techniques of Chan, or to any similar type of devices or applications, cannot be the only reason for randomly applying the same to Chan.

To support an obviousness rejection, including a rejection based upon "predictable results", there must be evidence of the same in the record. Otherwise, the rejection fails to meet a prima facie obviousness level.

Only the present application provides any reason for using the proposed combination of elements. Further, only the present application provides the discovered need for a change in the Background of the Invention. Lastly, only the present application provides the identified benefits of the features detailed in the claims.

Outside the discussion in the present application there is no other reason to look to the the storing method described in Keery, and no other reason to use such a storing method in Chan.

Accordingly, it is further respectfully submitted that the only apparent reason for the Office Action's modifying the storing method of Keery into Chan is derived from Applicant's own disclosure, which is improper and cannot support a prima facie obviousness case.

Accordingly, one skilled in the art would not have had a reason to combine the teachings

of Chan with those of Keery, and the rejection under 103(a) is improper. Therefore, Applicant respectfully requests any future rejection provide articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. Further, any subsequent Office Action should be made non-final to give Applicant an opportunity to review the Office's position as to these arguments and to clarify the record for appeal.

CONCLUSION:

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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